



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,548	08/20/2003	Vivien Chan	59516-159/PP-01602.006	7950

27476 7590 01/24/2007
NOVARTIS VACCINES AND DIAGNOSTICS INC.
CORPORATE INTELLECTUAL PROPERTY R338
P.O. BOX 8097
Emeryville, CA 94662-8097

EXAMINER

O HARA, EILEEN B

ART UNIT	PAPER NUMBER
----------	--------------

1646

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/644,548

Applicant(s)

CHAN ET AL.

Examiner

Eileen B. O'Hara

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 18-20 and 24-27 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 21 and 23 is/are allowed.
- 6) ☒ Claim(s) 12, 13, 15, 16 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/10/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 1646

DETAILED ACTION

1. Claims 1-16 and 18-27 are pending in the instant application. Claims 12-16 and 21-23 have been amended and claim 17 has been canceled as requested by Applicant in the Paper filed November 8, 2006.

Claims 1-11, 18-20 and 24-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 12-16 and 21-23 are currently under examination.

Priority

2. Applicant is reminded of the following requirement:

In a continuation or divisional application (other than a continued prosecution application filed under 37 CFR 1.53(d)), the first sentence of the specification or application data sheet (37 CFR 1.76) should include a reference to the prior application(s) from which benefit of priority is claimed, and also the status. See 37 CFR 1.78. The status of application 09/641,612 should be updated (now U.S. Patent No. 6,703,221).

Withdrawn Objections and Rejections

3. Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 12, 13 and 22 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to polypeptides having at least 95% sequence identity with the protein of SEQ ID NO: 2, or polypeptide of SEQ ID NO: 2 comprising at least one conservative amino acid substitution, or an epitope bearing portion of a polypeptide comprising the amino acid sequence of SEQ ID NO: 2 which comprises about 50 contiguous amino acids. Applicants have amended the claims to recite that the claimed polypeptides have at least one biological activity of the protein of SEQ ID NO: 2. The specification teaches that the polypeptide of SEQ ID NO: 2 can bind Notch receptor and promote angiogenesis. However, because claims 12 and 13 have the limitation that the polypeptide has at least one biological activity of the protein of SEQ ID NO: 2, it appears to encompass other, undisclosed activities. One of ordinary skill in the art would not know what structure such a protein would have. The rejection would be overcome by recitation of specific biological activities.

Art Unit: 1646

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 16 are indefinite because they encompass an epitope-bearing portion of a polypeptide comprising SEQ ID NO: 2, wherein the epitope-bearing portion comprises at least 50 contiguous amino acids. However, a polypeptide comprising the sequence of SEQ ID NO: 2 also encompasses polypeptides that have additional sequences at either or both ends of the polypeptide, and those sequences would also have epitope-bearing portions that would not be from the protein of SEQ ID NO: 2, so the metes and bounds are not clear. The rejection would be overcome by replacing "comprising" with "consisting of" in claim 15.

It is believed that all pertinent arguments have been answered.

Conclusion

- 9.1 Claims 14, 21 and 23 are allowed.
- 9.2 Claims 12, 13, 15, 16 and 22 are rejected.
- 9.3 The full length sequence of SEQ ID NO: 2 is free of the prior art.

Art Unit: 1646

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nichol can be reached at (571) 272-0835.


The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Eileen B. O'Hara, Ph.D.

Patent Examiner


EILEEN B. O'HARA
PRIMARY EXAMINER